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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775.821	02/10/2004	Hiroyasu Kurashina	81752.0154	8188
26021 7590 06/11/2008 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			EXAMINER ZHENG, JACKY X	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/775,821	Applicant(s) KURASHINA, HIROYASU	
	Examiner JACKY X. ZHENG	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 10, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendments and remarks filed on March 10, 2008.
2. **Claims 1, 6 and 8** have been amended.
3. **Claims 9-12** have been cancelled.
4. **Claims 1-8** are currently pending.
5. The rejections under 35 U.S.C. §101 to Claims 9-12 are withdrawn in view of Applicant's cancellations of the claims.
6. The rejections under 35 U.S.C. §112, Second Paragraph, to Claims 1-12 are withdrawn in view of Applicant's cancellations and/or amendments to the claims.

Response to Arguments

7. Applicant's arguments filed March 10, 2008 have been fully considered but they are not persuasive.
8. In re Applicant's remarks from Page 6, 6th paragraph to Page 8, 1st paragraph, regarding the rejection made under 35 U.S.C. §102(b) with regard to Claims 1, 6 and 8, Applicant mainly asserts that a) "...there is no disclosure of a function designated out of a plurality of displayed printing options... instead the user in a text input mode hits a function key on keyboard 10 without choosing from a display of print options...the function keys and corresponding print option are not displayed or chosen from the display..."; and b) Makino et al. "fails to disclose or suggest applicant's hierarchic display structure". Applicant's argument(s) are fully considered, however found to be not persuasive for at least the following reasons.

a. With respect to argument a), Examiner submits that independent claims 1 and 6 are both drawn to "a printing apparatus" respectively, and each specifically requires the claim limitation, *inter alia*, "tentative option designating means for designating at least one option out of the plurality of options displayed as a tentative option on the display screen, wherein the tentative option is related to printing" (which relates to the discussion of argument 'a' above), and further as evidences of Applicant's original disclosure, such as (but not limited to), Pg. 22, ln 10-16 of 2nd Paragraph, discloses that "...that the option can be determined ("decided") by pressing the "selection" key; that the option ... the tentative option can be changed ("selected") by using the various cursor keys ("←", "↑", "↓" and "→");", therefore interpretation of the required claim limitation of "tentative option designating means" to be the keys (such as the ones from standard typing keyboard) will be within the reasonable scope as evidenced both by Applicant's disclosure (as indicated above) and Applicant's lack of providing further structural descriptions for limiting. Therefore, the disclosure of prior art as set forth previously, in Makino et al., i.e. Figure 1, Part 10 "Keyboard", such as Fig. 1, 13 "Help Key", function key "Print" and etc. clearly anticipates the limitation of "tentative option designating means" for at least the discussion above. Furthermore, as both claims 1 and 6 are each drawn to the printing apparatus, in accordance with MPEP 2114, provided that "...claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function...", and the keys from the keyboard in Makino et al. and the cursor keys as disclosed in the original disclosure (as "tentative option designating means") are, at least structurally equivalent if not both structurally and functionally

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equivalent for one of ordinary skill in the art, as for the mere purpose of designating or selecting an option.

b. With respect to argument b) of allegedly failed to disclose or suggest applicant's hierarchic display structure (as the one pointed out by Applicant in Figure 6 of original disclosure), such arguments are fully considered and however respectfully found to be not persuasive. Examiner respectfully submits that although the claims are interpreted in light of the specification, however limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is respectfully reminded that in order for such specific limitations to be considered, the claim languages require to *specifically* recite such limitations in the claim, otherwise *broadest reasonable* interpretations of the broadly claimed limitations are deemed to be proper.

Therefore, for at least the reasons set forth above, the rejection made under 35 U.S.C. §102(b) over Makino et al. with regard to claims 1, 6 and 8 are remained proper and therefore maintained.

9. In re Applicant's remarks from Page 8, 2nd paragraph, Applicant asserts that the corresponding dependent claims 2-5 and 7 "are not anticipated or obvious over" the prior arts for same reasons above. Applicant's argument(s) are fully considered, however since the rejection of claims 1, 6 and 9 are maintained for at least the reasons stated above, the grounds of rejection for dependent claims 2-5 and 7 are also maintained since applicant has not pointed to the deficiencies of the rejection.

(The grounds of rejection and/or objection are maintained for at least the responses set forth above, reasons of record set forth previously, and also replicated and provided in below.)

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-4, 6 and 8** are rejected under 35 U.S.C. 102(b) as being anticipated by **Makino et al. (U.S. Patent No. 5,388,251)**

With regard to claim 1, the claim is drawn to a printing apparatus (*see Makino et al., i.e. Figure 1*) having: display means capable of option display in which a plurality of options related to printing are displayed on a display screen (*see Makino et al., i.e. Figure 1, Part 11 and Figure 2*); tentative option designating means for designating at least one arbitrary option out of the plurality of options as a tentative option on the display screen (*see Makino et al., i.e. Figure 1, Part 10, specifically column 4, line 24, "function keys", such as: Up, Down, Left and Right keys*); selection determination means for determining the tentative option as a determinate option (*see Makino et al., i.e. Figure 1, Part 10, i.e. "Enter/Return key"*); and print means for printing based on the determinate option (*see Makino et al., i.e. Figure 1, Part 12*), wherein said printing apparatus comprises: explanation requesting means capable of requesting, before the determination, a handling explanation including at least one of an operating explanation for guiding a next operation from a state of the option display and a function explanation for explaining a function of the tentative option (*see Makino et al., i.e. Figure 1, Part 13, "Help*

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Key”); and display switching means (*see Makino et al.*, i.e. Figure 2, Part 21 “Buffer Switching Unit”) for switching, when the handling explanation is requested, display of the display screen from the option display to explanation display that is display of the handling explanation.

With regard to claim 2, the claim is drawn to the printing apparatus according to claim 1, wherein: a plurality of display modes are defined inclusive of an option display mode for commanding the option display (*see Makino et al.*, i.e. Figures 2, 3A) and an explanation display mode for commanding the explanation display; said explanation requesting means requests the handling explanation by switching from the option display mode to the explanation display mode (*see Makino et al.*, i.e. Figure 2); and said display switching means allows the display screen to perform the option display in the option display mode and the display of the handling explanation in the explanation display mode (*see Makino et al.*, i.e. Figure 2).

With regard to claim 3, the claim is drawn to the printing apparatus according to claim 2, wherein said explanation requesting means is key operation means for alternately switching between the option display mode and the explanation display mode by operating an identical key (*see Makino et al.*, i.e. Figure 1, Part 13 “Help Key”).

With regard to claim 4, the claim is drawn to the printing apparatus according to claim 1, further comprising: explanation printing commanding means for commanding explanation printing in which the handling explanation is printed by said print means before the determination (*see Makino et al.*, i.e. Figure 1, Part 13 “Help Key”, serves as “explanation printing commanding means” to commanding “the explanations” to be printed onto the display screen within the printer);.

With regard to claim 6, the claim is drawn to a printing apparatus (*see Makino et al.*, i.e. *Figure 1*) having: display means capable of option display in which a plurality of options related to printing are displayed on a display screen (*see Makino et al.*, i.e. *Figure 1, Part 11*); tentative option designating means for designating at least one arbitrary option out of the plurality of options as a tentative option on the display screen (*see Makino et al.*, i.e. *Figure 1, Part 10, column 4, line 24, "function keys", such as: Up, Down, Left and Right keys*); selection determination means for determining the tentative option as a determinate option (*see Makino et al.*, i.e. *Figure 1, Part 10, such as "Enter/Return Key"*); and print means for printing based on the determinate option *see Makino et al.*, i.e. *Figure 1, Part 12*), wherein said printing apparatus comprises: explanation requesting means capable of requesting, before the determination, a handling explanation including at least one of an operating explanation for guiding a next operation from a state of the option display and a function explanation for explaining a function of the tentative option (*see Makino et al.*, i.e. *Figure 2*); and explanation printing commanding means for commanding explanation printing in which the handling explanation is printed by said print means when the handling explanation is requested (*see Makino et al.*, i.e. *Figure 1, Part 13 "Help Key", serves as "explanation printing commanding means" to commanding "the explanations" to be printed onto the display screen within the printer*).

With regard to claim 8, the claim is drawn to a method of displaying explanations of a printing apparatus which displays a plurality of options related to printing on a display screen, specifies at least one arbitrary option as a tentative option, determines the tentative option as a determinate option, and performs printing based on the determinate option, said method comprising: an explanation requesting step capable of requesting, before the determination, a

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handling explanation including at least one of an operating-explanation for guiding a next operation from a state of option display, in which the plurality of options are displayed, and a function explanation for a function of the tentative option; and an explanation executing step of executing one of a display switching step of switching display of the display screen from the option display to display of the handling explanation when the handling explanation is requested, and an explanation printing step of printing the handling explanation on an object to be printed
(The claim is rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claims 1 and 6 above).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Makino et al. (U.S. Patent No. 5,388,251)** (and *alternatively* over **Hastings et al. (U.S. Patent No. 5,885,012)**).

With regard to claim 5, the claim is drawn to the printing apparatus according to claim 4, wherein an object to be printed in the explanation printing is one which can be attached to an object of attachment through an adhesive surface.

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With regard to claim 7, the claim is drawn to the printing apparatus according to claim 6, wherein an object to be printed in the explanation printing is one which can be attached to an object of attachment through an adhesive surface.

Makino et al. does not *explicitly* disclose in words that "an object" to be printed "can be attached to an object of attachment through an adhesive surface". However, Examiner is herein taking an official notice that such claimed "object" having "an adhesive surface" is well-known in the field of label printing and/or general printing. Providing a few instances here for purpose of discussion (but not limited to the ones listed below in view of claim scope), such as: label sheets with adhesive surface, adhesive tape cassette/cartridge, sticker paper, Post-It[®] Notes, and etc. in order to allow the users to further secure or stabilize the adhesive substrate or medium with adhesive surface on the surfaces one desires.

In addition, for purpose of advancing the prosecution, prior art, Hastings et al. is also cited for the record for illustrating the printing substrate or medium with adhesive property is well-known, and disclosure of adhesive tape is provided in Hastings et al.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Stadler (U.S. Patent No. 4,899,276) discloses a field-directed screen help technique.

B. Hayama (U.S. Patent No. 6,115,024, Seiko Epson) discloses a display device, switched between a text displaying an image of a character string corresponding to text data on a

display screen thereof and an image display mode for displaying an image corresponding to image data on the displaying screen.

- C. Sakai et al. (U.S. Pub. No. 2005/0057761, Seiko Epson) disclose a tape printing system, method of data processing in printing system, program and memory medium.
- D. Miyasaka (U.S. Pub. No. 2005/0007606 A1, Seiko Epson) discloses a printing apparatus, a display method of the printing apparatus and etc.
- E. Kurashina (U.S. Pub. No. 2003/0218773, Seiko Epson) discloses a method of processing character in tape printer as well as tape printer.
- F. Sakuragi et al. (U.S. Patent No. 5,609,424) disclose a tape-shaped label producing device having input instructing messages.
- G. Hayama et al. (U.S. Patent No. 6,384,922, Seiko Epson) discloses a tape printer.
- H. Nunokawa et al. (U.S. Patent No. 6,092,947, Seiko Epson) disclose a tape printing device.
- I. Nunokawa et al. (U.S. Patent No. 5,651,619, Seiko Epson), disclose a tape printing device with display.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacky X. Zheng whose telephone number is (571) 270-1122. The examiner can *normally* be reached on Monday-Friday, 7:30 a.m.-5p.m., Alt. Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacky X. Zheng/

Patent Examiner

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June 24, 2008

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625

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